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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,542	08/03/2001	Daniel L. Schwarz	P-5204	6838

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EXAMINER

SORKIN, DAVID L

ART UNIT PAPER NUMBER

1723

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/921,542

Applicant(s)

SCHWARZ ET AL.

Examiner

David L. Sorkin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's amendment filed on 06 March 2006 and IDS filed 07 March 2006 have been entered.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 07 March fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each non-patent literature publication or that portion which caused it to be listed. The non-patent literature references have not been considered. The patent references have been considered.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 19-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 19, there is lack of antecedent basis for "the longitudinal axis of the vessels". It is unclear if the invention is limited to vessels having a symmetry such that a longitudinal axis is defined.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 19-26, 28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonney (US 4,477,192). Regarding claim 19, Bonney ('192) discloses a system comprising a plurality of sample vessels (20), each of the sample vessels comprising a growth medium and a stirrer (76), the stirrer capable of being influenced by a magnetic force (see col. 4, line 15-32); and an incubation and measurement module comprising at least one panel (16 and/or 30 and/or 24) comprising a plurality of openings (18 and/or 32 and/or 26) for holding the sample vessels, and a magnet driver (40,42,58,66) comprising a plurality of magnets (66), wherein each of the openings corresponds with one of the magnets (see Figs. 2-5), wherein the magnet driver is adapted to repeatedly move each magnet proximate to and distance from the surface of a corresponding sample vessel (see col. 4, lines 15-23), and wherein the openings are configured to hold the one or more sample vessels (see col. 2, lines 50-55). The act of orienting a longitudinal axis of the vessels at an angle of less than 90 degrees with respect to the horizontal is not disclosed. However, the system would be capable of being used in such a manner, for example by orienting the entire apparatus at an appropriate angle to the horizon. "[T]he manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey*,

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152 USPQ 235 (CCPA 1967). Regarding claim 20, the plurality of openings are arranged in at least one row and at least one column (see Fig. 2). Regarding claim 21, during operation of the magnetic driver, the movement of the magnet imposes a magnetic influence on the stirrer in the corresponding sample vessel to move the stirrer (see col. 4, lines 15-32). Regarding claim 22, the magnet driver further comprises a magnet shaft assembly (42,58,66) comprising a shaft (42) and the plurality of magnets (66) attached to the shaft, and a motor (40) engaged with the shaft to rotate the magnet shaft assembly and move the magnets proximate to the outer surface of the corresponding sample vessel and distant from the corresponding sample vessel. Regarding claims 23-25, the device would be capable of being used in the claimed manner. Regarding claim 26, the sample vessels are vials (20). Regarding claim 28, the magnet driver comprising a magnet shaft assembly (42, 58, 66) comprising a shaft (42) and a plurality of magnet assemblies (adjacent pairs of magnets 66) are coupled to the shaft, the magnet assemblies being discrete components or discrete parts of a single component or combinations thereof, wherein the magnet assemblies comprise a first magnet coupled to and extending from the shaft at a first angle and a second magnet coupled to and extending from the shaft at a second angle (see Fig. 4) and wherein the first magnet corresponds with a first of the one or more openings and the second magnet corresponds with a second of the one or more openings adjacent to the first of the one or more openings. Regarding claim 29, the magnets of the adjacent magnet assemblies are oriented approximately 180 degrees with respect to each other about the shaft (see Fig. 4).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonney (US 4,477,192). The system of Bonney ('192) was discussed above. As a housing (12) is further disclosed; however, it is not expressly stated that the housing has a door. It would have been obvious to one of ordinary skill in the art to have provided the housing with a door, for example to service or otherwise access component within the housing.

***Allowable Subject Matter***

9. Claim 30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***


10. Applicant's arguments are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 571-272-1148. The examiner can normally be reached on 9:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David L. Sorkin  
Primary Examiner  
Art Unit 1723

DLS